UNITED STATES PATENT AND TRADEMARK OFFICE

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10/627,085	07/24/2003	Christopher D. Williams	42P6485C	3138

45209 7590 09/25/2009	EXAMINER	
INTEL/BSTZ	SCHNURR, JOHN R	
BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP		
1279 OAKMEAD PARKWAY	ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>01 July 2009</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-33</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-33</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   This Office Action is in response to the Amendment After Non-Final Rejection

filed 07/01/2009. Claims 1-33 are pending and have been examined.

Response to Arguments

2.   Applicant's arguments filed 07/01/2009 have been fully considered but they are

not persuasive.

In response to applicant's arguments (Remarks pgs. 2-3) that Ellis fails to

anticipate the claimed invention, the examiner respectfully disagrees. As previously

explained Fig. 18 of Ellis shows a display listing preference lists, which are inherently

stored preference lists as it is not possible to display data which is not stored. These

lists correspond to the identified user and are accessed when the user indicates a

choice of one of the displayed lists. Applicant further argues that there are no lists in

Fig. 18, merely labeled boxes, however, one of ordinary skill in the art would easily

ascertain that the labeled boxes of Fig. 18 correspond to lists of content.

In response to applicant's arguments (Remarks pg. 4) that claim 1 has been

amended in an effort to overcome the 35 USC § 101 rejection, the examiner notes that

no such amendment has been received and pg. 2 line 2 of the Remarks indicates that

no claims have been amended.

Claim Rejections - 35 USC § 101

3.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

Claims 1-14 are rejected under 35 U.S.C. 101 as not falling within one of the four

statutory categories of invention. While the claims recite a series of steps or acts to be

performed, a statutory "process" under 35 U.S.C. 101 must (1) be tied to another

statutory category (such as a particular apparatus), or (2) transform underlying subject

matter (such as an article or material) to a different state or thing (Reference the May

15, 2008 memorandum issued by Deputy Commissioner for Patent Examining Policy,

John J. Love, titled "Clarification of 'Processes' under 35 U.S.C. 101"). The instant

claims neither transform underlying subject matter nor positively tie to another statutory

category that accomplishes the claimed method steps, and therefore do not qualify as a

statutory process. In this case the method of choosing a list is not tied to a particular

apparatus as the method steps may be performed manually.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5.   Claims **1-4, 6, 10-18, 20-25 and 30-32** are rejected under 35 U.S.C. 102(e) as

being anticipated by **Ellis et al. (US Patent 7,185,355)**, herein Ellis.

Consider **claim 1**, Ellis clearly teaches a method of choosing a preferences list
comprising:

receiving a user identification for a current user; **(Fig. 10: The user selects a profile to make active, column 9 lines 51-54.)**

identifying multiple stored preferences lists corresponding to the current user by searching a set of stored preferences lists, at least some of the preferences lists of the set of stored preferences lists corresponding to specific users, each of the preferences lists containing multiple entertainment programming channel identifiers; **(Fig. 18: The system displays lists 182, which correspond to the active users profile, column 12 lines 15-31.)**

providing a list display of the identified stored preference lists corresponding to the current user; **(Fig. 18)**

selecting one of the identified stored preferences lists by receiving a user choice of one of the multiple identified preferences lists of the list display; **(The user selects one of the lists 182, column 12 lines 32-39.)**

accessing the chosen preferences list. **(Fig. 19: The chosen list is displayed to the user, column 12 lines 32-39.)**

Consider **claim 2**, Ellis clearly teaches receiving a category identification from the current user; wherein identifying comprises searching the set of stored preferences lists also for the identified category; and wherein selecting one of the identified preferences lists includes the identified preferences lists for the identified category. **(Fig. 18: The displayed lists 182 correspond to categories and the user selects a category, column 12 lines 15-39.)**

Consider **claim 3**, Ellis clearly teaches identifying comprises searching the set of stored preferences lists also for generic preferences lists not corresponding to a specific user, and wherein selecting one of the identified preferences lists includes the identified generic preferences lists. **(If the user turns off the favorites always-on display mode the preferences lists displayed will correspond to the master profile, column 12 lines 4-8 and column 15 lines 4-7.)**

Consider **claim 4**, Ellis clearly teaches the stored preferences lists each correspond to at least one of a user and a category. **(Fig. 18: The lists correspond to the user and a category, column 12 lines 15-39.)**

Consider **claim 6**, Ellis clearly teaches receiving a new channel request; and determining a channel from the chosen preferences list to provide in response to the new channel request. **(When the user changes the channel the next channel in the preferences list is tuned, column 12 lines 40-62.)**

Consider **claim 10**, Ellis clearly teaches receiving an update request from a user; and updating the chosen preferences list in accordance with a received user input. **(The user may update the profile, column 10 lines 18-54.)**

Consider **claim 11**, Ellis clearly teaches the update request includes an indication of the particular preferences list that is to be updated. **(column 10 lines 18-54)**

Consider **claim 12**, Ellis clearly teaches the indication of the particular preferences list comprises a user selection from a list display. **(column 10 lines 18-54)**

Consider **claim 13**, Ellis clearly teaches if a reorder channel listings input is received, updating comprises changing the order of the channels in the list in accordance with the reorder channel listings input. **(column 14 lines 25-32)**

Consider **claim 14**, Ellis clearly teaches verifying that the identified user is authorized to access the lists and if the user is not authorized, then not updating the preferences list. **(Fig. 28: The user can require a PIN be used to access or edit the profile, column 14 line 60 to column 15 line 3.)**

Consider **claim 15**, see claim 1.
Consider **claim 16**, see claim 2.
Consider **claim 17**, see claim 3.
Consider **claim 18**, see claim 4.

Consider **claim 20**, see claim 1.
Consider **claim 21**, see claim 2.

Consider **claim 22**, Ellis clearly teaches the user interface further comprises a remote control device with at least one of a particular category button, channel selection keys corresponding to a particular category, and an alphanumeric input. **(Fig. 1: Remote control 50 contains channel number keys, column 5 lines 47-53, and the ability to enter alphabetical characters, column 10 lines 58-63.)**

Consider **claim 23**, see claim 3.
Consider **claim 24**, see claim 6.

Consider **claim 25**, Ellis clearly teaches a channel selection controller to maintain a record of the current channel being provided to the user; and wherein the channel selector is further to compare the current channel being provided to the chosen preferences list, and if the current channel being provided is in the

chosen preferences list, then to determine that the channel in the preferences list subsequent to the current channel being provided is the next channel. **(The system knows the current channel and when a channel change is requested the next channel in the list is tuned, column 12 lines 40-62.)**

Consider **claim 30**, see claim 10.
Consider **claim 31**, see claim 14.

Consider **claim 32**, see claims 1 and 22.

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7.   Claims **5, 7-9, 19, 26-29 and 33** are rejected under 35 U.S.C. 103(a) as being

unpatentable over **Ellis et al. (US Patent 7,185,355)** in view of **Stinebruner (US Patent**

6,133,910).

Consider **claim 5**, Ellis clearly teaches choosing a preference list and accessing content via programming identifiers displayed in the list.

However, Ellis does not explicitly teach the identifiers identifying particular communication paths for entertainment programming from any one of a wide variety of different transport media.

In an analogous art, Stinebruner, which discloses a system for receiving and displaying video content, clearly teaches identifiers identifying particular communication paths for entertainment programming from any one of a wide variety of different transport media. **(Fig. 1: Video signals are received via a plurality of sources 5, column 4 line 63 to column 5 line 18. Fig. 2: Virtual channel numbers are assigned to each programming channel and associated with source information, column 7 lines 3-15.)**

Therefore, at the time the invention was made, it would have been obvious to one with ordinary skill in the art to modify the system of Ellis by identifying

particular communication paths for entertainment programming from any one of a wide variety of different transport media, as taught by Stinebruner, for the benefit of simplifying the tuning process when video content is received from multiple sources (see column 2 lines 26-39 Stinebruner).

Consider **claim 7**, Ellis combined with Stinebruner, as in claim 5, clearly teaches tuning a component of an entertainment system to the determined channel once the next channel is determined **(When the user changes the channel the next channel in the preferences list is tuned, column 12 lines 40-62 Ellis.)** by sending a message to a component controller indicating an appropriate device within the entertainment system that is a source for the determined channel, as well as an identifier of the determined channel. **(column 5 line 56 to column 6 line 14 Stinebruner)**

Consider **claim 8**, Ellis combined with Stinebruner, as in claim 5, clearly teaches the chosen preferences list includes information that identifies a component within the entertainment system to tune to the determined channel. **(Virtual channel numbers are assigned to each programming channel and associated with source information, column 7 lines 3-15 Stinebruner.)**

Consider **claim 9**, Ellis combined with Stinebruner, as in claim 5, clearly teaches accessing an electronic programming guide (EPG) database to identify a component for tuning to the determined channel. **(Virtual channel numbers are assigned to each programming channel and associated with source information, column 7 lines 3-15 Stinebruner.)**

Consider **claim 19**, see claim 8.
Consider **claim 26**, see claim 7.
Consider **claim 27**, see claim 7.
Consider **claim 28**, see claim 8.
Consider **claim 29**, see claim 9.
Consider **claim 33**, see claim 9.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to JOHN SCHNURR whose telephone number is

(571)270-1458. The examiner can normally be reached on M-F 9a-5p.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

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published applications may be obtained from either Private PAIR or Public PAIR.

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John W. Miller/

Supervisory Patent Examiner, Art Unit 2421

JRS